

Remarks

Applicant disagrees with the contention made in the February 25, 2003 Office Action that claims 31-36, 49-50, 52, and 62-63 are in improper Markush format requiring amendment to only set forth the elected group. This is based on applicant's belief that (a) the claims are not in Markush format, and (b) the Patent Office cannot require that a claim that encompasses more than one invention be amended to only encompass one invention. These contentions are further discussed below.

The MPEP, at 2173.05(h) defines a Markush group as reciting members as being "selected from the group consisting of A, B and C". Thus, a Markush claim specifically identifies alternatives that encompass the entire scope of a particular limitation. The instant claims make no such specific identification, and are therefore not Markush claims.

The law is also clear that the Patent Office cannot require that a claim that encompasses more than one invention be amended to encompass only one invention. The PTO cites *In re Weber*, 198 USPQ 328 (CCPA 1978) to support its contention to the contrary. However, *In re Weber* states,

An applicant is given, by the statute, the right to claim his invention with the limitations he regards as necessary to circumscribe that invention, with the proviso that the application comply with the requirements of § 112. We have decided in the past that § 112, second paragraph, . . . allows the inventor to claim the invention as he contemplates it. *In re Wolfrum*, 486 F.2d 588, 179 USPQ 620 (CCPA 1973).

As a general proposition, an applicant has a right to have *each* claim examined in the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that

claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim.

...

We hold that a rejection under § 121 violates the basic right of the applicant to claim his invention as he chooses.

*In re Weber*, 198 USPQ at 331-332, emphasis in original.

In the instant case, the claims currently pending describe the invention as the applicant chooses. It would be contrary to *In re Weber* to require that the cited claims be amended to only include one group, as defined in the Restriction Requirement.

The ruling in *In re Weber* has also become part of administrative patent practice. MPEP 803.02 states in part,

...

A Markush-type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits. The provisional election will be given effect in the event that the Markush-type claim should be found not allowable. Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. . . .

...

... [S]hould no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. . . . The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim.

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MPEP 803.02.

Applicant asserts that the PTO should classify the subject claims as "linking claims", defined in MPEP 809.03 as claims linking together the inventions that are otherwise divisible. Again, MPEP 809.03 makes it clear that "Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application." Form Paragraph 8.12, under MPEP 809.03.

In conclusion, applicant strongly believes that the PTO cannot require that a claim encompassing two inventions be amended to encompass only one invention. Rather, the PTO must examine, in this case, the elected Group I, including the linking claims (i.e., claims 31-36, 49-50, 52, and 62-63) with respect to elected Group I, then, if Group I is allowed, examine the linking claims with respect to (nonelected) Group II. If the linking claims are deemed patentable with respect to Group II, the PTO must withdraw the restriction requirement and allow the provisionally restricted Group II claims that include all the limitations of the allowed linking claims.

Applicant believes that all preliminary matters are resolved with this Reply. Examination of the elected Group I claims (and the linking claims) is therefore respectfully requested. If there are any minor matters preventing examination of those claims, applicant respectfully requests that Examiner Johannsen contact the undersigned attorney.

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It is believed that no fee is required for this Reply. However, if there are anticipated fees required to maintain the pendency of this application, the PTO is authorized to withdraw those fees from Deposit Account 01-1785. Overcharges may also be credited to Deposit Account 01-1785.

Respectfully submitted,

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